

REMARKS

This Amendment is submitted simultaneously with filing of a Request for Continuing Examination.

In the final Office Action the Examiner rejected Claim 9 under 35 USC 102(d) over the U.S. Patent to Sakurai.

Claims 1-3, 5 and 11 were rejected over 35 USC 103(a) over the U.S. patent to Davidson in view of the U.S. patent to Powers.

Claims 4, 6-8 and 10 were rejected under 35 USC 103(a) over the U.S. patent to Davidson in view of the U.S. patents to Powers and Jameson.

Also, Claims 1 and 11 were rejected under 35 USC 112, first paragraph, and Claim 2 as rejected under 35 USC 112, second paragraph.

In connection with the Examiner's formal rejections, Claim 2 has been cancelled and Claims 1 and 11 have been amended to define that the covering cap (3) has a recess into which sheets are inserted, as disclosed in lines 21-22 on page 2 of the specification.

It is believed that the Examiner's grounds for the formal rejection of the claims under 35 USC 112 should be considered as not tenable and should be withdrawn.

Turning now to the Examiner's grounds for rejection of the claims over the art, and in particular to the rejection of Claim 9, it is respectfully submitted that the patent to Sakurai applied against this claim discloses a fire detector which is significantly different from the fire alarm as defined in Claim 9. Claim 9 specifically defines that the fire alarm in accordance with the present invention has a sheet (2, 2.1) which is located between the covering cap (3) and the fire alarm insert (1.1). The element (40) disclosed in the patent to Sakurai is however not a sheet, but instead the element (40) is a reflecting surface. It is therefore believed that this reference does not disclose the sheet similar to the sheet (2, 2.1) of the fire alarm in accordance with the present invention and located between the covering cap and the fire alarm insert.

Further, the patent to Sakurai does not disclose a faceplate which is similar to the faceplate (3.1) of the fire alarm in accordance with the present invention as defined in Claim 9. The element (20) in the Sakurai has a completely different function and it is not a faceplate. The element (20) is also not a faceplate which is arranged concentrically around the covering cap as defined in Claim 9.

It is therefore believed that the patent to Sakurai applied by the Examiner does not disclose the new features of the present invention as defined in Claim 9.

The Examiner rejected Claim 9 over this reference as being anticipated. In connection with this, it is believed to be advisable to cite the decision In Re: Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

The patent to Sakurai does not disclose each and every element of the fire alarm of the present invention as defined in Claim 9.

Therefore, the anticipation rejection of Claim 9 over this reference should be considered as not tenable and should be withdrawn.

The patent to Davidson applied by the Examiner against Claim 1 discloses a modular interchangeable cover (16). The cover (16) in this reference has an adaptor place which is identified with reference

numeral (29). However, the adaptor plate is not a sheet. Also, this reference does not disclose that the covering cap and the sheet cover the fire alarm insert. Instead in the system disclosed in this reference the insert (alarm module 28) covers the "sheet" (adaptor plate 29) and the covering cap (cover 30).

This reference therefore does not disclose the new features of the present invention as defined in Claim 1.

The U.S. patent to Powers also does not disclose the new features of the present invention as defined in Claim 1. The present invention as defined in Claim 1 also cannot be derived from the combination of the references. In order to arrive at the present application from the references, the references have to be fundamentally modified, and in particular by including into them the new features of the present invention which are now defined in Claim 1 and were first proposed by the applicants.

However, it is known that in order to arrive at a claimed invention by modifying the references, the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for

example, held in its decision In Re Randol and Redford (165 USPQ 586)

that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Claim 1 therefore should also be considered as patentably distinguishing over the art and should be allowed.

As for the Examiner's rejection of Claim 11, it should be emphasized that none of the references disclosed a sheet which is defined in Claim 11. The patent to Davidson discloses an adaptor plate (29) which is not a sheet. Furthermore, none of the references applied against Claim 11 disclose a set of sheets.

Claim 11 therefore should also be considered as patentably distinguishing over the art and should be allowed.

The Examiner's attention is also respectfully directed to the features of Claims 12 and 13. These features in combination with the features of Claim 1 also patentably distinguish the present invention from the prior art applied against the original claims.

Reconsideration and allowance of the present application with all the claims currently on file is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', written over the printed name.

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